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In re Application of:
FROSBURG, JOHN W et al
Serial No.: 10/693,005
Filed: October 24, 2003
Docket: 1023-294US01
Title: MEDICAL DEVICE PROGRAMMER
WITH INFRARED COMMUNICATION

6/18/09
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DECISION ON PETITION
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under 37 CFR 1.181
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This is a decision on the petition filed on June 1, 2009 filed under 37 CFR 1.181 seeking to have several grounds of rejections in the Examiner's Answer designated as new grounds of rejection.

The petition is being considered pursuant to 37 CFR 1.181, and no fee is required.

The petition is GRANTED.

The following relevant facts include:

1. A final rejection was mailed on May 3, 2007. Claims 1-12, 14-15, 17-21 and 32 were rejected under 35 U.S.C. 103(a) as unpatentable over Meadows in view of Whitehurst.
2. In response to the final rejection, the applicant filed an appeal brief on December 3, 2007 to appeal the finally rejected claims.
3. The examiner issued an Examiner's Answer to the appeal brief on April 1, 2009. In the answer, the examiner stated that a device including a software loading port, a housing defining an aperture for access to the port, and a plate member, as shown in claims 6-9, were well known in the art. The Examiner then presented two example devices to support this conclusion. The example devices are Samsung SCH-u740 cellular telephone and the Palm Centro device.

4. On June 1, 2009, the applicant filed the current petition arguing the examiner has improperly introduced the two example devices in support of his rejection, and these constitute a new ground of rejection raised in the Examiner's Answer. The applicant is looking for the rejection of claims 6-9, 11-12, 14-15, and 17 from the Examiner's Answer to be designated as new grounds of rejection.

Discussion and Analysis

A review of the examiner's answer shows that the examiner has augmented his arguments in the examiner's answer by introducing the new references by ways of example devices, namely Samsung SCH-u740 cellular telephone and the Palm Centro device. If the prior art references in the Final Rejection were properly applied under 35 USC 103, then it would not be necessary to add this new evidence to show that the features claimed are well known in the art. One skilled in this technology would already have known what is common practice in the art. The example of the Samsung cell phone and Palm Centro are unnecessary and should not have been added to support the rejection in the examiner's answer. If the citation of these cell phones was necessary to understand and explain the rejection, then they must have been applied against the claim under the rejection. Because the examiner listed these examples under the response to argument (on page 17 of the examiner's answer), the references to these items constitute new grounds of rejection.

In order to clarify the record and to comply with MPEP 1207.03¹, the examiner is directed to 1) vacate the examiner's answer of April 1, 2009; and 2) issue a revised examiner's answer without any reference to these newly cited example devices, if the examiner believes that the final rejection is proper, or 3) with the Technology Director's approval, to clearly identify the examiner's grounds of rejection in the revised examiner's answer as new grounds of rejection with any or all of the new references. Under the circumstance, the examiner does have the option to re-open prosecution (with supervisory approval) if the example devices are to be used as prior art references against the claims. The examiner is reminded that the rejection in an examiner's answer must be limited to the final rejection of the claims and the response to the applicant's arguments of March 21, 2008.

¹ MPEP § 1207.03, last paragraph states: A new prior art reference >applied or< cited for the first time in an examiner's answer generally will constitute a new ground of rejection. If the citation of a new prior art reference is necessary to support a rejection, it must be included in the statement of rejection, which would be considered to introduce a new ground of rejection. Even if the prior art reference is cited to support the rejection in a minor capacity, it should be positively included in the statement of rejection. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n. 3 (CCPA 1970).**>Where< a newly cited reference is added merely as evidence of the prior ** statement made by the examiner >as to what is "well-known" in the art which was challenged for the first time in the appeal brief<, the citation of the reference in the examiner's answer would not >ordinarily< constitute a new ground of rejection within the meaning of 37 CFR *> 41.39(a)(2)<. See also MPEP § 2144.03.

Conclusion

For the foregoing reasons, the relief requested by the petition is granted to the extent that the Examiner's Answer of April 1, 2009 is hereby vacated and a new revised examiner's answer will be mailed in due course.

The application is being forwarded to the examiner in Art Unit 3762 via the Supervisory Patent Examiner for further processing consistent with this decision. Appellant may file a request for reconsideration of this decision, without fee. However, such a request must be filed within two months of the date of this decision. See 37 CFR 1.181. Any inquiry regarding this decision should be directed to Henry Yuen, Special Programs Examiner, at (571) 272-4856.

PETITION GRANTED.

A handwritten signature in black ink, appearing to read "Jamy Wells for", is written over a horizontal line.

Donald T. Hajec, Director
Technology Center 3700